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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/738,911

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David W. Jenkins

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21005

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EXAMINER

MOUTAOUAKIL, MOUNIR

ART UNIT

PAPER NUMBER

2619

MAIL DATE

DELIVERY MODE

07/23/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/738,911

**Applicant(s)**

JENKINS ET AL.

**Examiner**

MOUNIR MOUTAOUKIL

**Art Unit**

2619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 04-14-2008 has been entered and entered.

Claims 1-20 are pending in this application.

Claims 1-20 are rejected as discussed below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added subject matter which is not described in the original disclosure is as follow: "...transmitting the groomed inbound traffic to at least one destination other than the multiple transport switches... received at the at least one local switch from at least one source other than the multiple transport switches...".

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, and 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, the recitation of "...at least one destination other than the multiple transport switches... received at the at least one local switch from at least one source other than the multiple transport switches ..." renders the claim vague and indefinite because it conveys a negative limitation by not specifying the destination/source in clear concise terms. Moreover, it is not clear if the source and destination are two different entities or not. Similar issue occurs in claims 10 and 18.

Claims 2-9, 11-12, 14-17, and 19-20 are rejected

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7, 9-13, 15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kam et al. (US 6,754,208).

Regarding claims 1, 10, and 18. Kam teaches: grooming inbound traffic at a first transport switch (Fig.2, 202) from a multiple transport switches for at least one local switch 202 and 206), the at least one local switch transmitting the groomed inbound traffic to at least one destination other then the multiple transport switches (groomed

intelligence is directed to one of the elements indicated as 204.1-204.M); and grooming at a second transport switch from among the multiple transport switches (206), outbound traffic received at the at least one local switch from at least one source other than the multiple transport switches (204.1-204.M, intelligence is directed from one of the 204 elements to a specific switch 206).

Regarding claim 2. Kam teaches: grooming of inbound and outbound traffic is performed independently (Fig.2).

Regarding claim 3, Kam teaches: grooming inbound traffic at a first transport switch for at least one local switch (Fig.2, element 202); and grooming outbound traffic at a second transport switch for the at least one local switch (Fig.2, element 206), wherein the switches are protocol switches (202 and 206, it is inherent that each switch has to follow specific set of rules, protocol).

Regarding claims 4 and 12. Kam teaches: configuring at least one local switch to operate with the first and second transport switches (Fig.2, element 204).

Regarding claim 5 and 13. Kam teaches: performing protocol switching at the at least one local switch (Fig.2).

Regarding claims 7 and 15. Kam teaches that the first and second transport switches are at least one of the following: wideband crossconnect switches, narrowband crossconnect switches, or broadband crossconnect switches (Fig.2).

Regarding claims 9 and 17. Kam teaches that the network grooming is performed in an electrical, optical, or wireless network (Fig.2, OC-N).

Regarding claims 11. Kam teaches: grooming of inbound and outbound traffic is performed free of tandem tying the first and second transport switches (Fig.2).

Regarding claim 19. Kam teaches: Grooming inbound traffic at the first transport switch includes separating higher speed traffic streams into lower speed traffic streams (202), and grooming outbound traffic at the second transport switch includes packing lower speed traffic streams into higher speed traffic streams (206).

Regarding claim 20. Kam teaches that the first transport switch separates higher speed traffic streams into lower speed traffic streams (202), and the second transport switch packs lower speed traffic streams into higher speed traffic streams (206).

***Claim Rejections - 35 USC § 103***

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kam.

Kam discloses all the limitations of claim 1.

Kam's system does not perform grooming at a third transport switch. However, since it is well known to perform grooming at two transport switches as disclosed in claim 1, the examiner takes an official notice that it's known to perform grooming or at least at a third transport switch. Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to perform multiple grooming at least at a third transport switch. The motivation for performing grooming at least a third, or more, transport switch being that it will allow data grooming throughout the network. Moreover, it will allow a smooth switch transition from one data rate traffic to another.

Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kam in view of Chu et al (US 6,947,629). Hereinafter referred to as Chu.

Regarding claims 8 and 16. Kam discloses all the limitations of the claimed invention with the exception that the network grooming is performed in a central office.

However, Chu discloses that switches can be located at a central office (col.1, lines 14-20). Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to perform network grooming in the central office, as taught by Chu, for the purpose of maintaining and supporting network switching locally.

### ***Response to Arguments***

Applicants' arguments filed 04-14-2008 have been fully considered but they are not persuasive.

Applicants contend that the amended independent claims are novel over the prior art of record.

Examiner respectfully disagrees, claims are interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim. Therefore, the prior art of record discloses all the limitations. The prior art of record (fig.2) grooms incoming traffic, at element 202-R, then forwards the groomed intelligence to one of the destinations 204-M, then element 204, as a source, forwards the intelligence to one of the transport switches, 206-R. The step of forwarding intelligence from one stage to another is not **random**.

Applicants argue that the switches are protocol switches and that Kam's switches are not protocol switches.



Examiner respectfully disagrees; Kam describes 202 and 206 as switches. Switches are known to provide a specific functionality in a network; the functionality is defined by a set of rules, known as protocol.

Note: based on MPEP 2144.03 "if applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate". Therefore, the common knowledge or well-known in the art statement is taken to be admitted prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art disclosed by the references cited or the objections made. Applicants must also show how the amendments avoid such references or objections. See 37C.F.R. 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOUNIR MOUTAOUAKIL whose telephone number is

(571)270-1416. The examiner can normally be reached on Monday-Thursday (1pm-4:30pm) eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. M./  
Examiner, Art Unit 2619

/Hassan Kizou/  
Supervisory Patent Examiner, Art Unit 2619